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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/579,808	05/16/2006	Jean-Marie Bernard	1022702-000190	5954
21839	7590	09/24/2008		
BUCHANAN, INGERSOLL & ROONEY PC				
POST OFFICE BOX 1404				
ALEXANDRIA, VA 22313-1404				
EXAMINER				
NILAND, PATRICK DENNIS				
ART UNIT		PAPER NUMBER		
1796				
NOTIFICATION DATE		DELIVERY MODE		
09/24/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com

Office Action Summary

Application No.

10/579,808

Applicant(s)

BERNARD ET AL.

Examiner

Patrick D. Niland

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2008.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-23 and 25-50 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 20-23 and 25-50 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/21/08 has been entered.

The amendment of 7/21/08 has been entered. Claims 20-23 and 25-50 are pending.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 35-37 and 49-50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. Claim 35 recites "A process for the preparation of an isocyanate composition comprising biuret functional groups, comprising the steps of (a) reacting at least on isocyanate monomer with an aminoalkylsilane to form an isocyanatoalkylsilane and (b) reacting the isocyanatoalkylsilane with an isocyanate for form a biuret wherein when the composition comprises a compound having at least one biuret bond and at least one aminoalkylsilane unit, the amino portion of the aminoalkylsilane unit is an amino group of the biuret." It would appear that the beginning of the claim absolutely requires a compound having at least one biuret bond and at least one aminoalkylsilane unit. However, the language "when the composition comprises a compound having at least one biuret bond and at least one aminoalkylsilane unit" makes this requirement appear optional due to the recitation of "when". It is therefore unclear if the moieties required by the recited steps are required or if they are optional as implied by "when".

The recited method does not require any biuret functional groups in the recited reactants nor their formation. There is no process step recited that makes the argued biuret group.

It is therefore unclear whether the claimed method requires the preamble limitation regarding biuret groups or is intended to have the full scope of the method claimed after the preamble, which does not require biuret groups. The applicant argues that the method requires the presence of a biuret group as defined in the specification. It is impermissible to read limitations from the specification into the claims. Given the Court's recognition that the applicant can be their own lexicographer, the lack of specific method steps or ingredients containing biuret, the claim language scope remains unclear for the above reasons.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 20-23, 25-34, and 38-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 3903052 Wagner et al..

Wagner discloses a composition containing the instantly claimed polyisocyanate compositions at column 1, lines 5-70 and column 2, lines 1-31, particularly the formula of columns 1 and 2, lines 15-30 in which B is chosen such that A is chosen from the diamine of column 2, lines 15-16, the subscripts n, p, and c are chosen so as to give the instantly claimed number of aminoalkylsilane units and diamino units from the values of column 2, lines 1-7, wherein the carbamate, i.e. urethane, groups and biuret groups of the reference meet the instantly claimed groups which derive from isocyanate functional groups as well as in which the terminal

group Q is a diamine and/or in which Q' contains an isocyanate group. It is understood that such mixtures of polymeric molecules contain molecules that vary in molecular weight as evidenced by average molecular weight, functionality as evidenced by average functionalities of polymers, and monomer sequencing. The composition of the patentee will therefore necessarily have the instantly claimed at least two distinct compounds. Molecules outside the scope of those claimed are encompassed by "comprising". The patentee does not specify the instantly claimed parameters only. It would have been obvious to one of ordinary skill in the art to use the compounds of Wagner et al. having the instantly claimed parameters because they are encompassed by Wagner and would have been expected to give compositions having the properties described by Wagner. Based on the viscosities of column 14, lines 15-20, the compositions of the patentee are expected to have viscosities of the instant claim 32.

6. Claims 35-37 and 49-50 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action. The prior art does not disclose these claimed inventions nor provide rationale to modify the prior art disclosures into these inventions.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Thursday from 10 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on 571-272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Patrick D Niland/
Primary Examiner,
Art Unit 1796